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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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THE HECKER LAW GROUP			BLACKWELL, JAMES H	
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SUITE 2300			ART UNIT	PAPER NUMBER
LOS ANGELES, CA 90067			2176	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/802,395	SPIELBERG, STEVEN	
	Examiner	Art Unit	
	James H. Blackwell	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 20 April 2007.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 60-74 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 60-63 and 68-74 is/are rejected.
- 7) Claim(s) 64-67 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 09 March 2001 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____	6) <input type="checkbox"/> Other: _____

Applicant's Response

In Applicant's Response dated 04/20/2007, Applicant filed a Request for Continued Examination, amended Claims 60 and 64-68, added new Claims 69-74, cancelled Claims 6 and 7, and argued against all objections and rejections previously set forth in the Office Action dated 10/23/2006.

Based on the amendment to the Specification, the objection to the Specification previously set forth is withdrawn.

Based on the amendment to Claim 1, the objections to the claim previously set forth are withdrawn.

Based on the amendment to Figure 13, the objection to the Drawings previously set forth is withdrawn.

Based on the amendment to Claim 60 and Applicant's Remarks, the rejections under 35 U.S.C. 112, first paragraph, previously set forth are withdrawn.

Based on the amendments to Claims 64-67 and Applicant's Remarks, the prior art rejections previously set forth for those claims are withdrawn.

Note that examiner James H. Blackwell has taken over examination of this application from primary examiner Doug Hutton.

Claim Objections

Claims 73 and 74 are objected to because of the following informalities:

- The claims recite the phrase “*wherein said smart mobile apparatus*” in Line 1, and no “*smart mobile apparatus*” is previously recited in the claims.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 60, 61, 63 and 68-74 are rejected under 35 U.S.C. 102(b) as being anticipated by Logan et al., U.S. Patent No. 5,732,216.

Claim 60:

Logan discloses *an apparatus for annotating a document* [see Column 1, Lines 42-65; see Column 3, Lines 24-41; see Column 6, Line 36 through Column 7, Line 2 → Logan discloses this limitation in that the system allows a user to record an annotation/comment for a text document using a mobile computing device], *comprising:*

- *a mobile apparatus* [see Column 1, Lines 42-65; see Column 3, Lines 24-41; see Column 6, Line 36 through Column 7, Line 2 → Logan discloses this limitation in

that the system allows a user to record an annotation/comment for a text document using a mobile computing device];

- *data storage coupled to said mobile apparatus* [see Figure 1; see Column 3, Line 24 through Column 4, Line 3 → Logan discloses this limitation, as clearly indicated in the cited figure and text], *said data storage configured to store a text document and a plurality of audio comments* [see Figure 1; see Column 3, Line 24 through Column 4, Line 3 → Logan discloses this limitation, as clearly indicated in the cited figure and text], *each of said stored plurality of audio comments annotating said text document and being linked to said text document* [see Column 1, Lines 50-65; see Column 12, Line 59 through Column 13, Line 22; see Column 19, Lines 23-43; see Column 41, Line 44 through Column 42, Line 27 → Logan discloses this limitation in that the system stores the text document and all annotations/comments associated with the document in a hierarchical tree structure having a parent/child relationship. That is, the text document is the “parent” and the annotations/comments are the “children.”];
- *a document processing engine coupled to said mobile apparatus* [see Figure 1; see Column 3, Line 24 through Column 4, Line 3 → Logan discloses this limitation, as clearly indicated in the cited figure and text], *said document processing engine configured to obtain an audio content conversion of said stored text document and at least a subset of said stored plurality of audio comments for playback as an audio source* [see Column 1, Line 41 through Column 2, Line 9; see Column 3, Lines 37-41; see Column 4, Lines 26-36; see

Column 4, Lines 40-52; see Column 5, Lines 16-31 → Logan discloses this limitation in that the system comprises a processor that is configured to retrieve the document, convert it to audio and play the converted document and a subset of the associated annotations to the user. The system allows users to limit access to their comments. Thus, the system discloses obtaining a “subset” of the “*plurality of audio comments*” in that a text document may comprise both “public” and “private” annotations/comments. In this case, the “public” annotations/comments would be retrieved and played back to the requesting user, whereas the “private” annotations/comments would not.]; and

- *an annotator coupled to said mobile apparatus* [see Figure 1; see Column 3, Line 24 through Column 4, Line 3 → Logan discloses this limitation, as clearly indicated in the cited figure and text], *said mobile apparatus comprising:*
 - *an audio playback interface configured to receive at least one command for controlling playback of said audio source from a user* [see Column 3, Lines 24-41; see Column 12, Line 52 through Column 15, Line 63 → Logan discloses this limitation in that the system, while the audio is being played to the user, is configured to allow the user to control playback of the converted document and the associated annotations/comments]; and
 - *an audio input device configured to obtain at least one new audio comment from said user at a point in said playback specified by said user* [see Column 12, Line 52 through Column 13, Line 22; see Column 15, Lines 10-46 → Logan discloses this limitation in that the system, while the

audio is being played to the user, is configured to allow the user to orally dictate an annotation/comment],

said annotator being configured to cause said new audio comment to be saved via said data storage as an annotation linked to a location in said text document based on said point in said playback specified by said user [see Column 12, Line 52 through Column 13, Line 22; see Column 15, Lines 10-46; see Column 19, Lines 25-43; see Column 40, Line 58 through Column 41, Line 47 → Logan discloses this limitation in that the system is configured to save the user's annotations/comments and associate the user's annotations/comments with particular portions of the text document about which the annotations/comments are concerned].

Claim 61:

Logan discloses *the apparatus of Claim 60, wherein said data storage comprises removable media* [see Column 6, Lines 58-61 → Logan discloses this limitation in that the system downloads the text documents onto a disk, which allows portable use of the text document].

Claim 63:

Logan discloses *the apparatus of Claim 60, wherein said audio source comprises a streaming media file* [see Column 4, Lines 4-16 → Logan discloses this limitation in that the system plays downloaded files in a streaming format].

Claim 68:

Logan discloses the apparatus of Claim 60, wherein each audio comment of said plurality of audio comments has a corresponding name of a user providing said audio comment [see Column 7, Line 5 through Column 8, Line 60; see Column 19, Lines 23-43 → Logan discloses this limitation in that the system stores data regarding the users making the annotations/comments], and said user identifies one or more commenting users whose comments said user wishes to be played back while the user is experiencing the audio source [see Column 7, Line 5 through Column 8, Line 60; see Column 19, Lines 23-43 → Logan discloses this limitation in that the system stores all data regarding the annotations/comments and allows the user to select text documents for playback based on the data].

Claim 69:

Logan discloses the apparatus of Claim 60, wherein said mobile apparatus is a smart mobile apparatus comprising said data storage, document processing engine and annotator [see Figure 1; see Column 1, Lines 42-65; see Column 3, Line 24 through Column 4, Line 3; see Column 6, Line 36 through Column 7, Line 2 → Logan discloses this limitation in that the system allows a user to record an annotation/comment for a text document using a mobile computing device. The mobile computing device "comprises" the recited elements in that it is a component of the overall system that includes each of the recited elements, as indicated in the above rejection for Claim 1. Moreover, Logan expressly states that "numerous other information storage, processing

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a communications schemes," including a "portable computer," may be used in the system.].

Claim 70:

Logan discloses *the apparatus of Claim 60, wherein said mobile apparatus is a telephone coupled to at least one computing device comprising said data storage, document processing engine and annotator* [see Figure 1; see Column 1, Lines 42-65; see Column 3, Line 24 through Column 4, Line 3; see Column 6, Line 36 through Column 7, Line 2 → Logan discloses this limitation in that the system allows a user to record an annotation/comment for a text document using a mobile computing device. The mobile computing device is the equivalent of the recited "telephone." Moreover, Logan expressly states that "numerous other information storage, processing a communications schemes" may be used in the system.].

Claim 71:

Logan discloses *the apparatus of Claim 60, wherein said mobile apparatus is coupled to at least one computing device comprising some or all of said data storage, document processing engine and annotator* [see Figure 1; see Column 1, Lines 42-65; see Column 3, Line 24 through Column 4, Line 3; see Column 6, Line 36 through Column 7, Line 2 → Logan discloses this limitation, as clearly indicated in the cited figure and text].

Claim 72:

Logan discloses the apparatus of Claim 60, wherein said mobile apparatus comprises one or more of said data storage, document processing engine and annotator [see Figure 1; see Column 1, Lines 42-65; see Column 3, Line 24 through Column 4, Line 3; see Column 6, Line 36 through Column 7, Line 2 → Logan discloses this limitation, as clearly indicated in the cited figure and text].

Claim 73:

Logan discloses the apparatus of Claim 72, wherein said smart mobile apparatus is a smart telephone [see Figure 1; see Column 1, Lines 42-65; see Column 3, Line 24 through Column 4, Line 3; see Column 6, Line 36 through Column 7, Line 2 → Logan discloses this limitation in that the system allows a user to record an annotation/comment for a text document using a mobile computing device. The mobile computing device is the equivalent of the recited “smart telephone.” Moreover, Logan expressly states that “numerous other information storage, processing a communications schemes” may be used in the system.].

Claim 74:

Logan discloses the apparatus of Claim 72, wherein said smart mobile apparatus is coupled to a computing device, and wherein said computing device comprising one or more of said data storage, document processing engine and annotator [see Figure 1; see Column 1, Lines 42-65; see Column 3, Line 24 through Column 4, Line 3; see

Column 6, Line 36 through Column 7, Line 2 → Logan discloses these limitations, as clearly indicated in the cited figure and text].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 62 is rejected under 35 U.S.C. 103(a) as being unpatentable over Logan, in view of Merrill et al., U.S. Patent No. 6,181,351.

Claim 62:

As indicated in the above rejection, Logan discloses every element of Claim 61.

Logan fails to expressly disclose a *removable memory comprising flash memory*.

Merrill teaches *an annotator* [see Column 7, Lines 12-15 – Merrill discloses this limitation in that the system is used to annotate a speech sound data stream] *having removable memory that comprises flash memory* [see Column 5, Lines 32-37 – Merrill discloses this limitation in that the system comprises many different types of computer memory, including flash memory], for the purposes of recording, storing and editing audio files [see Column 9, Lines 20-51].

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus, disclosed in Logan, to include *a removable memory comprising flash memory*, for the purpose of recording, storing and editing audio files, as taught by Merrill.

Allowable Subject Matter

Claims 64-67 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

Claim 64:

The prior art fails to disclose or suggest an apparatus comprising all of the recited limitations.

Claims 65-67:

These claims are dependent upon Claim 64 and thus include allowable subject matter.

Response to Arguments

Applicant's arguments filed 04/20/2007 have been fully considered but they are not persuasive.

Rejection of Claims Under 35 U.S.C. § 102(b):

Applicant argues that Logan limits user-initiated comments or annotations to the program segment that is being listened to by the user. That is, Applicant argues, Logan fails to teach converting a text document to audio, allowing a listener to audibly comment upon or annotate the text document during the audio playback of the text document, and saving the audio comment or annotation as a link to the commented upon/annotated portion of the text document. In the examiner's opinion, Applicant appears to argue that Logan allows the user to comment upon/annotate the program segment, wherein the program segment is an audio file rather than a text file. See Response – Pages 19-20, spanning paragraph.

The examiner disagrees.

The system in Logan includes "textual" program segments (see Figure 1, Element # 133; see Column 4, Lines 40-52). The system in Logan converts the text to audio and plays it for the user (see Column 3, Lines 24-41). The system in Logan allows the user to submit comments for the "converted" text program segment and saves the comments, the program segment commented upon and the position within that program segment when the comment was generated (see Column 1, Lines 53-59).

Thus, Logan does not limit user-initiated comments or annotations to the program segment that is being listened to by the user, but rather allows users to audibly comment upon or annotate text documents during audio playback of the text documents, and saving the audio comments or annotations as links to the commented upon/annotated portions of the text documents.

Conclusion

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Blackwell whose telephone number is 571-272-4089. The examiner can normally be reached on 8-5 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William D. Hutton can be reached on 571-272-4137. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

James H. Blackwell
07/06/2007



Doug Hutton
Primary Examiner
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